

REMARKS

Claims 1, 14-20, 22-32, and 34 are pending in this application. No changes have been made to the claims.

Rejection Under 35 U.S.C. § 102

Applicants respectfully request reconsideration of the rejection of claims 1, 14-20, 22-32, and 34 under 35 U.S.C. § 102(e) as being anticipated by *Seifert et al.* ("Seifert") (US 7,248,700 B2). Applicants respectfully submit that the *Seifert* reference does not qualify as prior art against the subject application under the provisions of section 102(e).

MPEP § 2136.03 states the following regarding 35 U.S.C. § 102(e) (emphasis added):

I. FOREIGN PRIORITY DATE

Reference's Foreign Priority Date Under 35 U.S.C. 119(a)-(d) and (f) Cannot Be Used as the 35 U.S.C. 102(e) Reference Date

35 U.S.C. 102(e) is explicitly limited to certain references "filed in the United States before the invention thereof by the applicant" (emphasis added). **Foreign applications' filing dates that are claimed (via 35 U.S.C. 119(a) - (d), (f) or 365(a)) in applications, which have been published as U.S. or WIPO application publications or patented in the U.S., may not be used as 35 U.S.C. 102(e) dates for prior art purposes.** This includes international filing dates claimed as foreign priority dates under 35 U.S.C. 365(a). Therefore, the foreign priority date of the reference under 35 U.S.C. 119(a)-(d) (f), and 365(a) cannot be used to antedate the application filing date. In contrast, applicant may be able to overcome the 35 U.S.C. 102(e) rejection by proving he or she is entitled to his or her own 35 U.S.C. 119 priority date which is earlier than the reference's U.S. filing date. *In re Hilmer*, 359 F.2d 859, 149 USPQ 480 (CCPA 1966) (Hilmer I) (Applicant filed an application with a right of priority to a German application. The examiner rejected the claims over a U.S. patent to Habicht based on its Swiss priority date. The U.S. filing date of Habicht was later than the application's German priority date. The court held that the reference's Swiss priority date could not be relied on in a 35 U.S.C. 102(e) rejection. Because the U.S. filing date of Habicht was later than the earliest effective filing date (German priority date) of the application, the rejection was reversed.). See MPEP § 201.15 for information on procedures to be followed in considering applicant's right of priority.

Note that certain international application (PCT) filings are considered to be "filings in the United States" for purposes of applying an application publication as prior art. See MPEP § 706.02(a).

II. INTERNATIONAL (PCT) APPLICATIONS; INTERNATIONAL APPLICATION PUBLICATIONS

If the potential reference resulted from, or claimed the benefit of, an international application, the following must be determined:

(A) If the international application meets the following three conditions:

- (1) an international filing date on or after November 29, 2000;
- (2) designated the United States; and
- (3) published under PCT Article 21(2) in English,

the international filing date is a U.S. filing date for prior art purposes under 35 U.S.C. 102(e). If such an international application properly claims benefit to an earlier-filed U.S. or international application, or priority to an earlier-filed U.S. provisional application, apply the reference under 35 U.S.C. 102(e) as of the earlier filing date, assuming all the conditions of 35 U.S.C. 102(e) and 35 U.S.C. 119(e), 120, or 365(c) are met. In addition, the subject matter relied upon in the rejection must be disclosed in the earlier-filed application in compliance with 35 U.S.C. 112, first paragraph, in order to give that subject matter the benefit of the earlier filing date under 35 U.S.C. 102(e). Note, where the earlier application is an international application, the earlier international application must satisfy the same three conditions (i.e., filed on or after November 29, 2000, designated the U.S., and had been published in English under PCT Article 21(2)) for the earlier international filing date to be a U.S. filing date for prior art purposes under 35 U.S.C. 102(e).

(B) If the international application was filed on or after November 29, 2000, but did not designate the United States or was not published in English under PCT Article 21(2), do not treat the international filing date as a U.S. filing date. In this situation, do not apply the reference as of its international filing date, its date of completion of the 35 U.S.C. 371(c)(1), (2) and (4) requirements, or any earlier filing date to which such an international application claims benefit or priority. The reference may be applied under 35 U.S.C. 102(a) or (b) as of its publication date, or 35 U.S.C. 102(e) as of any later U.S. filing date of an application that properly claimed the benefit of the international application (if applicable).

With regard to the *Seifert* reference in the instant case, the filing date of the corresponding German application (DE 101 43 728; filing date of September 6, 2001) may not be used for prior art purposes in accordance with section I of MPEP § 2136.03. Furthermore, the filing date of the corresponding international application (PCT/EP02/09405; filing date of August 22, 2002) also may not be used for prior art purposes in accordance with section II of MPEP § 2136.03 because the international application was not published in English, but instead was published in German. See WO 03/023605 A2 and *Seifert*, col. 1, lines 5-8. Therefore, the *Seifert* reference should be accorded its U.S. filing date of February 27, 2004, for prior art purposes.

Applicants' earliest claimed priority date is October 31, 2002, which predates the February 27, 2004 U.S. filing date of the *Seifert* reference. Therefore, the *Seifert* reference does not qualify as prior art against the subject application under section 102(e).

Accordingly, Applicants request that the rejection of claims 1, 14-20, 22-32, and 34 under 35 U.S.C. § 102(e) as being anticipated by *Seifert* be withdrawn.

Conclusion

In view of the foregoing, Applicants respectfully request reconsideration and reexamination of claims 1, 14-20, 22-32, and 34, and submit that these claims are in condition for allowance. Accordingly, a notice of allowance is respectfully requested. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at **(408) 749-6902**. If any additional fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees to Deposit Account No. 50-0805 (Order No. WACHP006).

Respectfully submitted,
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